

Remarks

This amendment responds to the Office action dated August 26, 2004. Claims 12–44 are pending in the application and are withdrawn from consideration. The Office action states that applicants' response filed June 3, 2004, is not fully responsive to the prior Office action. Applicants disagree and submit that this response was fully responsive and advanced prosecution. The rejection of claims 6–8 was rendered moot by applicants' cancellation of these claims.

Furthermore, claims 12–44 were filed in the response to provoke interference proceedings with U.S. Patent No. 6,573,369 to Henderson *et al.* (Henderson). The "statutory requirement of first inventorship should be given primary emphasis" (MPEP 2303.01), and thus applicants cancelled claims 6–8 to advance the present application towards declaration of an interference. Nonetheless, pursuant to the Examiner's request, applicants also have added new claims 45–47, which are identical to canceled claims 6–8. No new matter is added by this amendment. Moreover, the present response addresses the prior rejection of claims 6–8, as discussed further below.

Applicants Request Consideration of Claims 12–44 in the Present Application

The Office action states that claims 12–44 are withdrawn from consideration as being drawn to a non-elected invention. Applicants respectfully request that claims 12–44 be considered in the present application. MPEP 2303.01 sets forth several scenarios wherein the Examiner "should take action toward instituting interference." Scenario B of this section makes it clear that a prior election without traverse in response to a Restriction Requirement does not alter the Examiner's duty to take action towards instituting interference proceedings. MPEP 2307.03 also states that "an amendment presenting a claim to provoke an interference in an application not in issue is usually admitted and promptly acted on." Hence applicants respectfully request that the Examiner consider claims 12–44 and take action towards instituting an interference in the present application.

Rejections under 35 U.S.C. § 102(b)

The Office action dated December 16, 2003, rejects claims 6–8 (45–47) under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,252,743 to Barrett *et al.* (Barrett). The Office action also rejects claims 6 and 7 (45 and 46) as allegedly being anticipated by U.S. Patent No. 5,624,711 to Sundberg *et al.* (Sundberg). Applicants traverse the rejections over Barrett and Sundberg and request that they be withdrawn.

Neither Barrett nor Sundberg teaches the features of applicants' claim 45 and therefore the rejection of this claim over Barrett or Sundberg is improper. For example, neither reference teaches reacting one or more protein capture agents with a first subset of first hydrophilic chains in combination with reacting second hydrophilic chains with a second subset of first hydrophilic chains, as is set forth in subparagraphs b) and c) in claim 45. Because Barrett and Sundberg fail to teach this combination of features, claim 45 and claims 46 and 47, which depend from claim 45, are novel over the cited references. Moreover, Barrett and Sundberg fail to teach other features and combinations of features recited in claims 45–47 and thus these claims are further distinguishable from the teachings of the cited references. Barrett and Sundberg fail to teach the features recited in claims 45–47, and therefore applicants respectfully request that the claim rejections under 35 U.S.C. § 102(b) be withdrawn.

Moreover, neither Barrett nor Sundberg provides any motivation to combine or modify their teachings to provide a method as recited in applicants' claim 45. Neither reference suggests that such combinations or modifications are desirable, possible or likely to result in success. Therefore, applicants respectfully submit that a rejection of claims 45–47 under 35 U.S.C. § 103 would be improper.

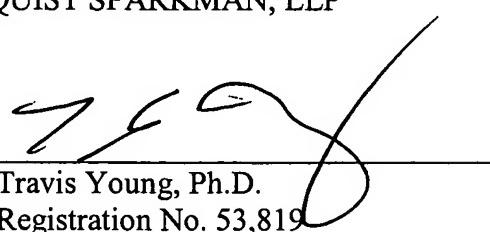
Conclusion

The present claims are in condition for allowance. As such, applicants respectfully request that interference proceedings between the present application and U.S. Patent No. 6,573,369 to Henderson *et al.* be initiated.

Respectfully submitted,

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